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G. Scott Knight

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EXAMINER

AN, IG TAI

ART UNIT

PAPER NUMBER

3687

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/661,822

**Applicant(s)**

KNIGHT ET AL.

**Examiner**

IG TAI AN

**Art Unit**

3687

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/12/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 17, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 12/08/2003, 10/25/2004, 12/07/2005.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.



### **DETAILED ACTION**

This communication is a First Office Action Non- Final Rejection on the merits. Upon the restriction/election, Claims 9 – 16 and 18 – 20 are elected. Therefore, Claims 9 – 16 and 18 – 20 are examined as set forth.

#### ***Information Disclosure Statement***

1. The information disclosure statement filed on 10/25/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. **Claims 9 – 11, 14 – 16 and 18 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tibbs et al. (Hereinafter Tibbs) (US 20020010689) in view of Tsunenari et al. (Hereinafter Tsunenari) (US 20020013744).**

**As per Claim 9**, Tibbs teaches a method for monitoring the use of a return-shipping label (Abstract), comprising:

receiving notification that a customer desires to return an item (Figure 1, Figure 3, Figure 4f and Paragraph 29 – 31 teaches system receive the return request from customer);

creating a return-shipping label for the customer's use (Figure 3, Figure 5 and Paragraph 34 teaches creating return-shipping label for the customer);

making the return-shipping label available for the customer's use (Figure 6 and Paragraph 34 teaches making return-shipping label available for the customer to use);

recording at least a time and date the return-shipping label was made available for the customer's use (Figure 3 and paragraph 36 teaches sending email notification to vendor concerning the returning product when return label is generated. Email contains time and date and more information. Therefore, the Examiner construes that system sending email to the vendor is equivalent to recording the time and date of the return-shipping label was made available to the customer);

notifying the customer of the return-shipping label's availability (Paragraph 38 teaches the email with web link for the return shipping label is sent to the customer);

receiving a network request to access the return-shipping label, wherein such network request originates with the customer (Figure 3, Figure 4d, Figure 4e, Figure 4f, Figure 6 and Paragraph 27 teaches a merchant system receive a customer's request to return item, and customer access return label on the merchant website after return request is approved).

However, Tibbs is silent regarding recording at least a date and time of the customer's access to the return shipping label, if accessed by the customer.

Tsunenari discloses system and methods to effect return of a customer product recording at least a date and time of the customer's access to the return shipping label, if accessed by the customer (Paragraph 83 teaches recording time when the return shipping label is provided to the customer).

Therefore, from this teaching of Tsunenari, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify generating return shipping label upon the request of customer for return product of Tibbs to include record time and date when customer access and obtain the return shipping label as taught by Tsunenari to confirm that customer retrieve the return shipping label.

Furthermore, all the claimed elements were known in the Tibbs and Tsunenari and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention.

**As per Claim 10**, Tibbs teaches providing the return-shipping label to the customer (Figure 3, Figure 5 and Paragraph 38 teaches creating and providing return-shipping label for the customer);

receiving at least a time and date that a package bearing the return- shipping label is received by a commercial carrier (Figure 3 and Paragraph 42 teaches delivery package is scanned and the package is continuously tracked throughout the delivery. In order to track delivery, it requires receiving date and time data and recording date and time data into the system. Therefore, the Examiner construes that tracking the package throughout the delivery is equivalent to receiving and recording the date and time of the package delivered by the commercial carrier); and

recording at least the time and date that the package bearing the return-shipping label is received by the commercial carrier (Figure 3 and Paragraph 42 teaches delivery package is scanned and the package is continuously tracked throughout the delivery. In order to track delivery, it requires receiving date and time data and recording date and time data into the system. Therefore, the Examiner construes that tracking the package throughout the delivery is equivalent to receiving and recording the date and time of the package delivered by the commercial carrier).

However, Tibbs is silent regarding recording at least a time and date the customer was provided the return- shipping label.

Tsunenari discloses system and methods to effect return of a customer product recording at least a time and date the customer was provided the return- shipping label (Paragraph 83).

Therefore, from this teaching of Tsunenari, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify generating return shipping label upon the request of customer for return product of Tibbs to include record time and date when customer access and obtain the return shipping label as taught by Tsunenari to confirm that customer retrieve the return shipping label.

Furthermore, all the claimed elements were known in the Tibbs and Tsunenari and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention.

**As per Claim 11**, Tibbs teaches making the recorded information about at least the date and time the return-shipping label was made available to the customer (Figure 3 and paragraph 36 teaches sending email notification to vendor concerning the returning product when return label is generated. Email contains time and date and more information. Therefore, the Examiner construes that system sending email to the vendor is equivalent to recording the time and date of the return-shipping label was made available to the customer),

at least the time and date the package bearing the return-shipping label is received by the commercial carrier available to the merchant (Figure 3 and Paragraph

42 teaches delivery package is scanned and the package is continuously tracked throughout the delivery. In order to track delivery, it requires receiving date and time data and recording date and time data into the system. Therefore, the Examiner construes that tracking the package throughout the delivery is equivalent to receiving and recording the date and time of the package delivered by the commercial carrier).

However, Tibbs is silent regarding recording the date and time of the customer's access to the return-shipping label, and at least the date and time the customer obtained the return-shipping label.

Tsunenari discloses system and methods to effect return of a customer product recording the date and time of the customer's access to the return-shipping label, and at least the date and time the customer obtained the return-shipping label (Paragraph 83 teaches recording time when the return shipping label is provided to the customer).

Therefore, from this teaching of Tsunenari, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify generating return shipping label upon the request of customer for return product of Tibbs to include record time and date when customer access and obtain the return shipping label as taught by Tsunenari to confirm that customer retrieve the return shipping label.

Furthermore, all the claimed elements were known in the Tibbs and Tsunenari and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention.

**As per Claim 14**, Tibbs teaches wherein the recorded information at least the date and time the return-shipping label was made available to the customer (Figure 3 and paragraph 36 teaches sending email notification to vendor concerning the returning product when return label is generated. Email contains time and date and more information. Therefore, the Examiner construes that system sending email to the vendor is equivalent to recording the time and date of the return-shipping label was made available to the customer),

at least the time and date the package bearing the return-shipping label is received by the commercial carrier available to the merchant so that the merchant can develop a reasonable estimate of the date the return item will arrive at a location designated by the merchant (Figure 3 and Paragraph 42 teaches delivery package is scanned and the package is continuously tracked throughout the delivery. In order to track delivery, it requires receiving date and time data and recording date and time data into the system. Therefore, the Examiner construes that tracking the package throughout the delivery is equivalent to receiving and recording the date and time of the package delivered by the commercial carrier).

However, Tibbs is silent regarding recording the date and time of the customer's access to the return-shipping label, and at least the date and time the customer obtained the return-shipping label.

Tsunenari discloses system and methods to effect return of a customer product recording the date and time of the customer's access to the return-shipping label, and at

least the date and time the customer obtained the return-shipping label (Paragraph 83 teaches recording time when the return shipping label is provided to the customer).

Therefore, from this teaching of Tsunenari, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify generating return shipping label upon the request of customer for return product of Tibbs to include record time and date when customer access and obtain the return shipping label as taught by Tsunenari to confirm that customer retrieve the return shipping label.

Furthermore, all the claimed elements were known in the Tibbs and Tsunenari and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention.

**As per Claim 15**, Tibbs teaches receiving at least a time and date the package bearing the return-shipping label is delivered by the commercial carrier (Figure 3 and Paragraph 42 teaches delivery package is scanned and the package is continuously tracked throughout the delivery. In order to track delivery, it requires receiving date and time data and recording date and time data into the system. Therefore, the Examiner construes that tracking the package throughout the delivery is equivalent to receiving and recording the date and time of the package delivered by the commercial carrier); recording at least the time and date the package bearing the return- shipping label is delivered by the commercial carrier (Figure 3 and Paragraph 42 teaches delivery package is scanned and the package is continuously tracked throughout the

delivery. In order to track delivery, it requires receiving date and time data and recording date and time data into the system. Therefore, the Examiner construes that tracking the package throughout the delivery is equivalent to receiving and recording the date and time of the package delivered by the commercial carrier); and

making the recorded information about at least the time and date the package bearing the return-shipping label is delivered by the commercial carrier available to the merchant (Figure 3 and Paragraph 42 teaches delivery package is scanned and the package is continuously tracked throughout the delivery. In order to track delivery, it requires receiving date and time data and recording date and time data into the system. Therefore, the Examiner construes that tracking the package throughout the delivery is equivalent to receiving and recording the date and time of the package delivered by the commercial carrier).

**As per Claim 16**, Tibbs teaches wherein the recorded information of at least the date and time the return-shipping label was made available to the customer (Figure 3 and paragraph 36 teaches sending email notification to vendor concerning the returning product when return label is generated. Email contains time and date and more information. Therefore, the Examiner construes that system sending email to the vendor is equivalent to recording the time and date of the return-shipping label was made available to the customer),

at least the time and date the package bearing the return-shipping label is received by the commercial carrier (Figure 3 and Paragraph 42 teaches delivery

package is scanned and the package is continuously tracked throughout the delivery. In order to track delivery, it requires receiving date and time data and recording date and time data into the system. Therefore, the Examiner construes that tracking the package throughout the delivery is equivalent to receiving and recording the date and time of the package delivered by the commercial carrier), and

at least the time and date the package bearing the return-shipping label is delivered by the commercial carrier is made available to the merchant so that the merchant can develop a reasonable estimate of the date the return item arrives at a location designated by the merchant (Figure 3 and Paragraph 42 teaches delivery package is scanned and the package is continuously tracked throughout the delivery. In order to track delivery, it requires receiving date and time data and recording date and time data into the system. Therefore, the Examiner construes that tracking the package throughout the delivery is equivalent to receiving and recording the date and time of the package delivered by the commercial carrier).

However, Tibbs is silent regarding recording the date and time of the customer's access to the return-shipping label, and at least the date and time the customer obtained the return-shipping label.

Tsunenari discloses system and methods to effect return of a customer product recording the date and time of the customer's access to the return-shipping label, and at least the date and time the customer obtained the return-shipping label (Paragraph 83 teaches recording time when the return shipping label is provided to the customer).

Therefore, from this teaching of Tsunenari, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify generating return shipping label upon the request of customer for return product of Tibbs to include record time and date when customer access and obtain the return shipping label as taught by Tsunenari to confirm that customer retrieve the return shipping label.

Furthermore, all the claimed elements were known in the Tibbs and Tsunenari and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention.

**As per Claim 18**, Tibbs teaches providing a merchant computer with an application for generating a return-shipping label for use by a customer to return an item purchased from the vendor (Figure 3, Figure 5 and Paragraph 34 teaches creating return-shipping label for the customer);

receiving a communication from a customer desiring to return an item purchased from the merchant (Figure 1, Figure 3, Figure 4f and Paragraph 29 – 31 teaches system receive the return request from customer);

in response to the customer's communication, executing the application with the merchant computer to generate an electronic return-shipping label for transmission to the customer via a network (Figure 3, Figure 5 and Paragraph 34 teaches creating return-shipping label for the customer);

executing the application to transmit data necessary for shipping the item to a designated return location from the merchant computer to a service provider computer via a network (Figure 3, Figure 4D, Figure 4F and Paragraph 27 – 32 teaches merchant server and customer who is connected to the merchant server transmitting all return item data to the service provider computer using network such as internet);

generating a return-shipping label for returning an item at the service provider computer (Figure 5 and Paragraph 34 teaches generating return–shipping label);

transmitting a notification of availability of the return-shipping label for download to a customer via a network, the notification having a network resource identifier to identify a network location for downloading the electronic return-shipping label (Paragraph 38 teaches the email with web link for the return shipping label is sent to the customer);

recording at least a date and time that the notification was made to the customer in a database associated with the service provider computer (Figure 3 and paragraph 36 teaches sending email notification to vendor concerning the returning product when return label is generated. Email contains time and date and more information. Therefore, the Examiner construes that system sending email to the vendor is equivalent to recording the time and date of the return-shipping label was made available to the customer); and

making at least a date and time that the notification was made to the customer available to the merchant computer over the network (Figure 3 and paragraph 36 teaches sending email notification to vendor concerning the returning product when

return label is generated. Email contains time and date and more information. Therefore, the Examiner construes that system sending email to the vendor is equivalent to recording the time and date of the return-shipping label was made available to the customer).

**As per Claim 19**, Tibbs teaches wherein the notification is an email notification provided to an email address of the customer, which e-mail address has been provided from the merchant computer to the service provider computer in the data necessary for shipping the item (Paragraph 38).

**As per Claim 20**, Tibbs teaches wherein the data necessary for shipping the item includes a return location address (Paragraph 32).

**4. Claims 12 - 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tibbs and Tsunenari as applied to claim 11 above, and further in view of [www.buy.com](http://www.buy.com).**

**As per Claim 12**, Tibbs and Tsunenari's combination teaches all the elements of the claimed invention but is silent regarding wherein the method is used for monitoring the use of a return-shipping label in the shipment of an electronic device.

[www.buy.com](http://www.buy.com) discloses wherein the method is used for monitoring the use of a return-shipping label in the shipment of an electronic device (Front page).

All the component parts are known in Tibbs and Tsunenari's combination and www.buy.com. The only difference is the combination of the "old elements" into a single system by Tibbs and Tsunenari's combination to sell electronic device online.

Therefore, it would have been obvious to one of ordinary skilled in the art to combine selling electronic devices and generating return-shipping label as known methods with no change in their respective functions, and combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

**As per Claim 13**, Tibbs and Tsunenari's combination teaches all the elements of the claimed invention but is silent regarding wherein the electronic device is one or more chosen from the group consisting of a computer, video projector, television, video recorder, stereo device, audio recorder, video display device, radio receiver, radio transmitter, two-way communication device, cellular telephone, digital telephone, analog telephone, personal digital assistant, printer, facsimile device, copier, paging device, camera, and combinations thereof.

www.buy.com discloses wherein the electronic device is one or more chosen from the group consisting of a computer, video projector, television, video recorder, stereo device, audio recorder, video display device, radio receiver, radio transmitter, two-way communication device, cellular telephone, digital telephone, analog telephone, personal digital assistant, printer, facsimile device, copier, paging device, camera, and combinations thereof (Front Page).

All the component parts are known in Tibbs and Tsunenari's combination and www.buy.com. The only difference is the combination of the "old elements" into a single system by Tibbs and Tsunenari's combination to sell electronic device online and electronics are defined as a computer, video projector, television, video recorder, stereo device, audio recorder, video display device, radio receiver, radio transmitter, two-way communication device, cellular telephone, digital telephone, analog telephone, personal digital assistant, printer, facsimile device, copier, paging device, or camera.

Therefore, it would have been obvious to one of ordinary skilled in the art to combine selling electronic devices and generating return-shipping label as known methods with no change in their respective functions, and combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chalmers et al. (20020152093) discloses system and method for initiating returns over a network.

Hauser et al. (US 6536659) discloses facilitating returns of merchandise purchased from other sources.

Taskett et al. (US 20040212833) discloses system and method for generating shipping labels.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IG TAI AN whose telephone number is (571)270-5110. The examiner can normally be reached on Monday - Thursday from 9:30 AM to 5 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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